



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,654	08/03/2001	Anshul Amar	ATH-001	5834
42532	7590	03/12/2008		
PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110			EXAMINER PASS, NATALIE	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 03/12/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/921,654

Applicant(s)

AMAR ET AL.

Examiner

Natalie A. Pass

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-16, 18-20, 24-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-16, 18-20, 24-28, 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 10 December 2007. Claims 1, 3, 15, 20, 27-28, and 31 have been amended. Claims 7-8, 17, 21-23 and 29 have been canceled. Claims 1-6, 9-16, 18-20, 24-28, 30-33 remain pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Newly amended claims 1, 15, 20, 27, 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 1, 15, 20, 27, 28 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "to correct an error by applying a new rule, an updated rule, or both," as disclosed at lines 24-25, 27-28, 24-25, 23-24, 25-26, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 3 August 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 3 August 2001.

5. The rejection of claims 1 and 27 under the second paragraph of 35 U.S.C. 112 for lack of antecedent basis is hereby withdrawn due to the amendment 10 December 2007.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 13-16, 18-20, 24-28, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 and Campbell et al., U.S. Patent Number 6, 047, 259, for substantially the same reasons given in the previous Office Action (paper number 20070829), and further in view of Holloway et al., U.S. Patent Number 5, 253, 164. Further reasons appear hereinbelow.

(A) Claims 1, 15, 20, 27, 28 have been amended to recite the limitations of

- “submitting the insurance claim to the payor server” in line 23;
- “automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server ” in lines 24-25; and
- “automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server” in lines 26-28.

Claims 1, 20, 27, 28 have been amended to recite the limitations of

- “in the insurance company rules database,” in line 19, 19, 16, 20, respectively;

(A) As per newly amended claims 1, 15, 20, 27, 28, Burks and Campbell teach a method for managing a medical practice as analyzed and discussed in the previous Office Action (paper number 20070829) comprising:

... [...] ... defined by one or more insurance rules in the insurance company rules database (Burks; column 3, lines 59-61); and

(i) submitting the insurance claim to the “trading partner” (reads on “payor”) server (Burks; column 3, line 60 to column 4, line 6).

Burks and Campbell fail to explicitly disclose

(j) automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server; and

(k) automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server.

However, the above features are well-known in the art, as evidenced by Holloway.

In particular, Holloway teaches

(j) automatically and repeatedly interacting with the insurance claim to correct an error by applying a new rule, an updated rule, or both received from the payor server (Holloway; column 3, lines 16-67); and

(k) automatically and repeatedly updating the one or more insurance rules in the insurance company rules database that apply to the payor server by applying the new rule, the updated rule, or both received from the payor server (Holloway; column 3, lines 30-36, column 4, line 67 to column 5, line 3, column 10, lines 51-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Burks and Campbell to include these limitations, as taught by Holloway, with the motivations of providing “a cost effective automated data

processing system” that will “detect and correct ... [claims] ... errors” by using “expert systems as applied to the field of medical claims analysis and decision-making mechanisms for analyzing and applying payments to ... [...] ... medical claims” (Holloway; column 1, lines 11-13, column 2, lines 14-16 column 3, lines 6-13).

The remainder of claims 1, 15, 20, 27, 28 is rejected for the same reasons given in the prior Office Action (paper number 20070829, section 7, pages 3-13), and incorporated herein.

The motivations for combining the respective teachings of Burks and Campbell are as given in the rejection of claim 1 in the prior Office Action (paper number 20070829) and incorporated herein.

(B) The amendments to claims 3, 31 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20070829, section 7, pages 7-8, 13), and incorporated herein.

(C) Claims 2, 4, 5-6, 13-14, 16, 18-19, 24-26, 30, 32-33 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070829, section 7, pages 3-13), and incorporated herein.

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 and Campbell et al., U.S. Patent Number 6, 047, 259, and Holloway et al., U.S. Patent Number 5, 253, 164 as applied to claims 1 and 2 above, and further in view of Berman et al., U.S. Patent Number 5, 995, 939 for substantially the same reasons given in the previous Office Action (paper number 20070829). Further reasons appear hereinbelow.

(A) Claims 9-11 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20070829, section 8, pages 13-15), and incorporated herein.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 and Campbell et al., U.S. Patent Number 6, 047, 259, and Holloway et al., U.S. Patent Number 5, 253, 164, as applied to claims 1 and 2 above, and further in view of Ilsen et al., U.S. Patent Number 6, 757, 898 for substantially the same reasons given in the previous Office Action (paper number 20070829). Further reasons appear hereinbelow.

(A) Claim 12 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 20070829, section 9, pages 15-16), and incorporated herein.

Response to Arguments

10. Applicant's arguments on pages 16-18, 19-22 of the response filed 10 December 2007, with respect to claims 1-6, 9-16, 18-20, 24-28, 30-33 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that Applicant argues in paragraph 1 on page 18 of the 10 December 2007 response that the applied references fail to teach "verifies and checks each piece of information entered without human intervention ... [...] ... prior to the submission of an insurance claim ... [...]" It is noted that the features argued by Applicant are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Natalie A. Pass/
Examiner, Art Unit 3626
February 26, 2008

/Robert Morgan/
Primary Examiner, Art Unit 3626